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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,385	11/01/2001	Kunio Shimizu	56232.10 [4874]	9078
7590	08/10/2004		EXAMINER	
Squire, Sanders & Dempsey L.L.P. Suite 300 One Maritime Plaza San Francisco, CA 94111			RAJGURU, UMAKANT K	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/004,385	SHIMIZU ET AL.
	Examiner Umakant K. Rajguru	Art Unit 1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 January 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Art Unit: 1617

1. A response has been filed on Jan. 06, 2004.
2. Claims being examined are still 1-17.
3. Rejection of claims 1-3 under 35 USC 103 as being unpatentable over Michihata et al (US 6320042) is now withdrawn.

In the remaining rejections (in the same office action of Oct. 23, 2003), the primary reference Michihata is now deleted, and the said remaining rejections without Michihata are maintained, as set forth below.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07020317.

JP '317 discloses a polarizing plate provided with a polarizing film and protective films. Protective films are cellulose ester based and have a plasticizer at 3-9%wt.

Patentee does not mention variation in wt. and moisture permeability. Examiner holds the position that the film of patentee inherently satisfies these limitations unless proved otherwise, due to the similarity of both films. Therefore it would have been obvious to follow teachings of JP '317 and arrive at (claimed) invention.

5. Claims 4, 5, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07020317 in view of Russo (US 4262040).

Disclosure of JP '317 has been presented earlier. JP '317 does not mention any of specific plasticizers of instant claim 4.

Russo describes a decorative coating (col. 2, lines 16-31). The composition of coating includes organic solvents, balsams and plasticizers (col. 4, lines 1-32). Rosin esters happen to be suitable plasticizers.

It would therefore have been obvious to use the rosin esters of Russo, as suitable plasticizer, in the film of JP '317 with the expectation of obtaining enhanced flow during formation of film.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '317 in view of Russo (US 4262040) as applied to claims 4 and 5 above, and further in view of Cooprider et al (US RE 37563).

JP '317 together with Russo does not disclose hydrogenated rosin.

Cooprider discloses partially crosslinked microspheres and an adhesive using them. Patentee mentions hydrogenated rosin esters as suitable plasticizers (col. 9, lines 32-37).

Therefore it would have been obvious to include hydrogenated rosin in the film of JP '317 to enhance adhesion.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '317 in view of Russo (US 4262040) as applied to claim 4 above, and further in view of Bekele (US 5202188).

JP '317 together with Russo fails to mention (claimed) epoxy plasticizer.

Bekele discloses film comprising vinylidene chloride and a plasticizer containing epoxy groups (col. 7, line 20 to col. 8, line 2; col. 8, lines 23-25).

Hence it would have been obvious to use the epoxy plasticizer of Bekele as a preferred plasticizer in film of JP '317 to improve flow during extrusion of film.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '317 in view of Russo (US 4262040) as applied to claim 4 above, and further in view of Ueda et al (US 5698614).

JP '317 together with Russo fails to disclose (claimed) ketone resin as a plasticizer.

Ueda describes an ink composition comprising a ketone resin (abstract; col. 3, lines 16-18).

Therefore it would have been obvious to use ketone resin in the film of JP '317 to improve stability, leveling effect, water resistance and adhesion.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '317 in view of Russo (US 4262040) as applied to claim 4 above, and further in view of Honjo et al (US 4218362).

JP '317 together with Russo fails to mention (claimed) p-toluenesulfonamide resin as plasticizer.

Honjo discloses a powder marking agent in which p-toluenesulfonamide is used as a plasticizer (col. 5, liens 44-46).

Hence it would have been obvious to use in the film JP '317, p-toluenesulfonamide as plasticizer to achieve better flow properties.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '317 in view of Russo (US 4262040) as applied to claims 1 and 2 above, and further in view of Cooprider et al (US RE 37563).

Please see item 6 for this rejection.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '317 as applied to claim 1 above, and further in view of Bekele (US 5202188).

Please see item 7 for this rejection.

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '317 as applied to claim 1 above, and further in view of Ueda (US 5698614).

Please see item 8 for this rejection.

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '317 in view of Russo (US 4262040) as applied to claims 4 and 11 above, and futher in view of Honjo et al (US 4218362).

Please see item 9 for this rejection.

14. Claims 8 and 15 are objected to as being dependent upon a rejection base claim, but would be allowable if rewritten in independent form including all of limitations of the base claim and any intervening claims.

15. Applicants have submitted a declaration under 37 CFR 1.132 to show that primary reference JP 07020317 fails to render claims 1-17 unpatentable.

Examiner has considered said declaration. It has been found that the declaration is not a proper comparison with JP '317. Though the data in the declaration show superior properties over those of JP'317, the declaration, for above reasons, fails to obviate the cited rejection. Examples in a reference illustrate the

disclosed invention. They do not limit the invention. JP '317 discloses a protective film (of a polarizing plate) with a thickness of 50 μm or more. Said declaration is devoid of any data about a film of thickness of 50 μm to 150 μm as disclosed by JP '317. See p. 11 line 1 of JP '317. There should have been additional results of films with thickness of 50 μm , 150 μm and (say) 100 μm (a thickness in between 50 μm & 150 μm).

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umakant K Rajguru whose telephone number is 571-272-1077. The examiner can normally be reached on Monday thru Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-9306. The

fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rajguru/LR

July 22, 2004



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PRIMARY EXAMINER
GROUP 1500
1711